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09/989,007	11/21/2001	Judith C. Clark	040094/0101	9546

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FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

SPERTY, ARDEN B

ART UNIT	PAPER NUMBER
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1775

DATE MAILED: 10/16/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,007

Applicant(s)

CLARK, JUDITH C.

Examiner

Arden B. Sperty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 1,2,10,11,13-20,24-38,40,43 and 47-49 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-9,12,21-23,39,41,42,44-46 and 50-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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FINAL ACTION

Election/Restrictions

1. Newly submitted claims 47-49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to a species requiring a third object.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 47-49 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The amendment filed August 1, 2003, is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

- Claim 46: the limitation wherein the “first and second ends of the affixing element are not visible when the attachment device is viewed by a viewer facing the first surface of the backer/stabilizer”,
- Claims 50-52: melting the backer/stabilizer.

Applicant is required to cancel the new matter in the reply to this Office Action.

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Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 46 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The limitation wherein the “first and second ends of the affixing element are not visible when the attachment device is viewed by a viewer facing the first surface of the backer/stabilizer” was not described in the specification.

5. Claims 50-52 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. The “melting” process was not described in the specification.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the

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invention. As discussed in the personal interview on August 27, 2003, the claim is internally inconsistent because the preamble states that the affixing element is part of the first object, while the body of the claim states that the affixing element is part of the attachment device.

8. Claim 12 recites the limitation "bottom surface of the backer/stabilizer." There is insufficient antecedent basis for this limitation in the claim.

9. Claim 42 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As discussed in the personal interview on August 27, 2003, the use of the trademark Velcro renders the claim indefinite. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. Generic terminology should be used.

10. Regarding claim 46, any negative limitation or exclusionary proviso must have basis in the original disclosure. See *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of positive recitation is not basis for an exclusion. See MPEP 2173.05(i). In the instant case there is no basis for the negative limitation or exclusionary proviso in the original disclosure. The claim is also indefinite because it is not clear what makes the ends of the affixing element "not visible" by a viewer facing the first surface. Are the ends covered by something? Is the backer/stabilizer not transparent? It is unclear how the claim further limits claim 44.

11. Claims 50-52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as

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the invention. To what degree/state is the backer/stabilizer melted? It is not clear why one would want to melt the backer/stabilizer into a blob of plastic. What form does the backer/stabilizer take once the melting has been performed? And once the hardening has occurred? How is the melting performed? How does one melt the backer/stabilizer while at a [sic] same time fitting an affixing element onto the backer/stabilizer? What does “rigidly coupled” mean in claim 51? A search of the prior art has not been performed for claims 50-52 because the metes and bounds of the claims are unclear.

12. Claims 53-54 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what is meant by the affixing element being “configured to be affixed to the first object.” It is not clear what structure or configuration is being claimed. It is unclear what is meant by “the backer/stabilizer including at least one opening for receiving at least one of the first and second ends of the affixing element so as to affix the first object to the backer/stabilizer when the first and second ends of the affixing element are coupled to each other.” Is Applicant describing a process or a backer/stabilizer? What is actually required by this run-on nonsense sentence fragment? Also, how is the releasably attachable/deattachable [sic] unit “adapted” to be releasably deattached [sic]? What is this adaptation to which Applicant refers? How is the unit different after being adapted than it was before it was adapted? A search of the prior art has not been performed for claims 53-54 because it is unclear what is being claimed.

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Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

14. Claims 39, 41 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by 3M's Command Strip Adhesive, first used in commerce Jan 31, 2000, found on the 3M website (www.3m.com).

Regarding claims 39, 41 and 42, 3M's Command strip is a double-sided releasable adhesive tape with a non-adhesive portion used for releasably attaching a first object to another object. Specifically regarding claim 41, 3M shows the Command strip used to attach one solid object to another solid object.

15. Claims 3 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,633,215 to Anders.

Regarding claim 3, the Anders reference teaches an attachment device for a help-summoning device (first object) to be releasable attached to a vehicle (second object) (col 1, lines 48-55). The base (backer/stabilizer) has a first surface and a second surface opposite the first surface, the second surface having attached thereto a Velcro pad (releasably attachable unit) (col 2, lines 36-42; col 5, lines 13-30). A second Velcro pad (releasably attachable unit) is attached to the vehicle (second object) so that the first and second Velcro pads can contact each other (col 2, lines 36-42; col 5, lines 13-30). A patch of contact cement (adhesive unit) is adhered

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to the back of the second Velcro patch so that the Velcro patch may be adhered to the vehicle (second object) (col 5, lines 19-24). A socket 118 (attaching means) is used to attach the base 106 (backer/stabilizer) to the mast 108 of the help-summoning device (first object) (col 3, line 67- col 4, line 9).

Regarding claim 5, the socket (attaching means) comprises a socket 118 for connecting to a portion 116 of the mast 108 of the help-summoning device (first object), the socket 118 being integrally formed as part of the base (backer/stabilizer) (col 3, line 67- col 4, line 9; Figure 6).

Regarding claim 6, the socket 118 is a cavity for coupling to a portion 116 (protruding portion) of the help-summoning device (first object).

Claim Rejections - 35 USC § 103

16. Claims 3-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over *The American Heritage Dictionary of the English Language, Third Edition* in view of USPN 5,896,592 to Santa Cruz, USPN 5,004,144 to Selga, and USPN 5,123,139 to Leppert as stated in the previous office action.

17. Claims 8-9, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 2,424,762 to Loeb in view of USPN 4,993,783 to Omholt and USPN 5,123,139 to Leppert as stated in the previous office action.

18. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb, Omholt and Leppert as applied to claim 21 above, and further in view of USPN 5,896,592 to Santa Cruz and USPN 5,004,144 to Selga as stated in the previous office action.

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19. Claims 3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,165,549 to Hayduchok.

Regarding claim 3, the Hayduchok reference teaches an attachment device for a writing implement (first object) to be releasably attached to a desk, notebook, or other working surfaces (second object) (see abstract). The caddy 1 (backer/stabilizer) has a first surface and a second surface opposite the first surface, as seen in Figures 15 and 16, and a Velcro pad (first releasably attachable unit) having its back side adhered to the second surface of the caddy. Figure 16 further shows a second Velcro pad (second releasably attachable unit) adhered to a surface of a drawing case (second object) while Figures 1-12 show sockets (attaching means) for attaching the caddy (backer/stabilizer) to the pen(s) (first object) (also see col 1, lines 38-42, 63-68; col 2, lines 60-63; col 5, lines 21-42). Although the reference is silent with respect to an adhesive unit adhering the second Velcro pad to the second object, selecting the best materials for a particular application would have been obvious to one of ordinary skill in the art.

Regarding claim 5, the attaching means comprises a socket for connecting to a portion of the pens to attach the pens to the caddy, the socket being integrally formed as part of the caddy (col 1, lines 38-42)

Regarding claim 6, the socket (connecting element) is a cavity for coupling to the end (protruding portion) of a pen.

20. Claims 12 and 44-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 2,424,762 to Loeb, and further in view of USPN 4,993,783 to Omholt and USPN 5,123,139 to Leppert as applied to claims 8 and 9 in the previous office action.

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As stated in the previous office action regarding claim 8, Loeb teaches an object (first object) mounted on a display card (backer/stabilizer) including a wire having first and second ends (affixing element) and a method of producing the same. The display card (backer/stabilizer) includes two openings (see Fig. 2) through which the ends of the wire are fitted, and the first and second ends of the wire (affixing element) are coupled together (see 15 in Fig. 5) to provide a coupling of the object to the card (backer/stabilizer). The reference is silent with respect to the attachment of releasably attachable units to the back of the display card. Omholt teaches a display unit using Velcro attachment means for displaying merchandise. It would have been obvious to one of ordinary skill in the art to use the display unit disclosed by Omholt in its intended fashion to display the display card of Loeb. Therefore, it would have been obvious to adhere a first releasably attachable Velcro unit to the back of the card taught by Loeb, so that it may be releasably attached to the carpet/Velcro/hook and loop covered vertical display wall (second releasably attachable unit) (Omholt col 3, lines 50-59). Although Omholt is silent with respect to the means of attaching the carpet/Velcro/hook and loop material attachable to the display, it would have been obvious to one of ordinary skill in the art to select the best materials for the specific application, including an adhesive strip such as the one disclosed in USPN 5,123,139 to Leppert (col 3, lines 24-27) used to adhere Velcro to a surface.

As stated in the previous office action regarding claim 9, the card is made of rigid cardboard (Loeb col 2, lines 4-6). Selection of the best materials for a particular application is within the ordinary skill level of one in the art, therefore absent a showing of unexpected results with respect to the claimed plastic or card stock materials, it would have been obvious to one of

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ordinary skill in the art to use the claimed materials based on the ultimate intended use of the display card.

Regarding claim 12, although the references are silent with respect to forming a channel portion on the bottom surface of the backer/stabilizer, which in the instant case corresponds to the back surface of the display card taught by Loeb, it would have been obvious to one of ordinary skill in the art to form channels on the back of the card so that the card was flush with the Velcro pad and consequently with the display surface of Omholt. It is notoriously well-known to form a recess to allow something (a wire, string, rubber band, etc) to pass between two members while allowing the members to touch, flushly, around the wire, string, rubber band, etc. USPN 3,751,769 to Reiner, Figure 11 and USPN 5,649,758 to Dion, Figures 1 and 2 numeral 30, are cited herein as reference of this position.

Regarding claims 44-46, although the references do not specifically disclose the claimed location of the coupled ends, absent a showing of criticality with respect to where the coupled ends are located, such a requirement does not provide patentable distinction over the prior art because the location of the coupled ends does not affect the function of the attachment device. The requirement merely represents personal preference, and therefore would have been obvious to one of ordinary skill in the art.

Response to Arguments

21. The objections to the specification stated in the First Office Action have been overcome by the amendment.

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22. The 35 USC 112 rejections stated in the First Office Action have been overcome by the amendment.

23. Applicant's arguments filed August 1, 2003 have been fully considered but they are not persuasive.

Regarding claims 3-4 and 7 over the normal usage of Velcro in view of Santa Cruz, Selga and Leppert, Applicant's arguments are not commensurate in scope with the claims. The claims do not require a rigid backer/stabilizer. Applicant further argues, with respect to claim 4, that there is no motivation to sew or glue a foam portion of an adhesive strip to the first object. It should be noted, however, that claim 4 also allows for bonding or taping the backer/stabilizer to the first object, therefore the limitation is met by double-sided foam tape. The claim does not require that the means for attaching the backer/stabilizer is a separate entity from the backer/stabilizer. In the instant case the bonding means is an integral part of the backer/stabilizer. Applicant further argues, with respect to claim 7, that the claimed backer/stabilizer materials are sturdier than foam adhesive tape. Applicant does not, however, provide evidence comparing the rigidity of the claimed materials with that of the foam tape of the prior art, therefore the argument is moot. Card stock, for instance, comes in different weights, the lightweight card stock being less sturdy than foam tape.

Regarding 8-9 and 21, Applicant avers that claim 8 requires the first and second ends of the affixing element to be fitted through the first opening; however, claim 8 only requires that "at least one" of the first and second ends is fitted through the first opening. Further, it should be noted that patentability of a product lies in the product itself and not in the process per se. The process of making an article does not provide a patentable distinction over the art of record in the

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absence of a discernable difference in the article itself. Regardless of how many ends pass through an opening it remains that the product of the prior art includes a card (backer) with a wire passing therethrough, the ends of the wire being coupled together. Absent a showing of a patentable difference between the prior art and that of the instant claims no patentable distinction is seen. Applicant further argues that the card taught by Loeb is not used to provide backing or to stabilize the bolt. The examiner respectfully disagrees based on the definitions of “backing” and “stabilizer” as provided. Since a backing is “a part that supports or strengthens from the rear” as the card is doing from the rear of the bolt, and since a stabilizer is “one that makes or keeps something stable” as the card is doing for the bolt so it does not roll away, it is the examiner’s position that the card serves as a backer/stabilizer. Applicant’s argument that the coupling of the instant invention is more secure than the coupling taught by Loeb has been considered, but absent evidence thereof the argument is not persuasive. Lastly regarding claim 8, as discussed in the interview August 27, 2003, line 2 of the claim infers that the affixing element is part of the first object, whereas the last two lines of the claim infer that the affixing element is part of the attachment device. Appropriate correction is required.

Regarding claims 22 and 23, it appears that Applicant may have misunderstood the rejection. What was intended, for example, was a configuration wherein the object (of the Loeb reference) is attached to the display card (backer/stabler) by a wire (affixing element) and Velcro is attached to the back of the card using adhesive tape, the completed assembly being releasably attachable, by the Velcro, to the display unit taught by Omholt. It is therefore unclear what Applicant intends by the instant argument. The rejection stands.

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Regarding claims 39-42, Applicant has overcome the 35 USC 103(a) rejection stated in the First Office Action by amendment to the claims. The new rejection of these claims is stated above.

Conclusion

24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 5864925 to McGee and USPN 6572945 to Bries.

25. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

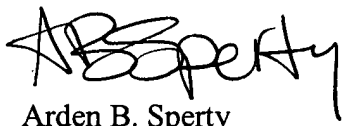
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is 703-305-3143. The examiner can normally be reached on M-R, 08:00-16:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 703-308-3822. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Arden B. Sperty
Examiner
Art Unit 1775



DEBORAH JONES
SUPERVISORY PATENT EXAMINER

September 30, 2003